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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/940,481	08/29/01	COZAR	R 212868USDX C

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IM52/0928

EXAMINER	
IF, S	
ART UNIT	**PAPER NUMBER**
1742	5

DATE MAILED: 09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)	
Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on 8/29/01.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1 - 8 is/are pending in the application.

Of the above claim(s) — is/are withdrawn from consideration.

☐ Claim(s) ____ is/are allowed.

☑ Claim(s) 1 - 8 is/are rejected.

☐ Claim(s) ____ is/are objected to.

☐ Claim(s) ____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on ____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on ____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) ____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: ____.

Attachment(s)

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other ____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-8 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5234512 to Inoue et al in view of USP 5236522 to Fukuda et al, USP 4932908 to Ishikawa et al, or USP 5164021 to Kato et al (All references are cited in the parent application).

4. The Inoue et al reference(s) disclose(s) the features including the claimed Fe-Ni shadow mask (abstract) and the conventional shadow mask processing steps such as etching and working (col. 1, lines 47-57). The difference between the Inoue et al

reference(s) and the claims are as follows: The Fe-Ni alloy of Inoue et al does not contain Co element and Inoue et al do not disclose the claimed equation expressing the chemical composition of the alloy. However, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, In re Cooper and Foley 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, Taklatwalla v. Marburg, 620 O.G. 685, 1949 C.D. 77, and In re Pilling, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. In re Austin, et al., 149 USPQ 685, 688.

5. With respect to the Co content, Fukuda et al (col. 2, lines 51-57), Kato et al (col. 2, lines 46-50), and Ishikawa et al (col. 3, lines 24-30) teaches the benefit of adding Co to Fe-Ni shadow mask materials in the same field of endeavor or the analogous metallurgical art. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to provide Fe-Ni alloy as Inoue et al with Co element as taught by Fukuda et al (col. 2, lines 51-57), Kato et al (col. 2, lines 46-50), and Ishikawa et al (col. 3, lines 24-30) in order to improve the etching adaptability of the Fe-Ni shadow mask material. It has been held that combining known ingredient having known functions to provide a

composition having the additive effect of each of the known functions is within realm of performance of skilled artisan and is not a patentable subject matter. In re Castner, 186 USPQ 213, 217.

6. With respect to the etching step in the Inoue et al reference which is known in the art meant for drilling. See MPEP § 706.02(a); In re Malcolm, 1942 C.D. 589; 543 O.G. 440.

Conclusion

7. This is a continuation of applicant's earlier Application No. 08/641,233. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination

of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been meet by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
September 27, 2001